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Paper No. 14
RLS/AP

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re *Optonics, Inc.*

Serial No. 75/586,933

Thomas P. Storer of Goodwin, Procter LLP for *Optonics, Inc.*

Rebecca Gilbert, Trademark Examining Attorney, Law Office
113 (*Meryl Hershkowitz*, Managing Attorney).

Before *Simms*, *Hairston* and *Rogers*, Administrative Trademark
Judges.

Opinion by *Simms*, Administrative Trademark Judge:

Optonics, Inc. (applicant), a California corporation,
by change of name from Silicon Metrics, Inc., has appealed
from the final refusal of the Trademark Examining Attorney
to register the mark OPTONICS for the following goods:

capital equipment for the semiconductor
manufacturing industry, namely,
inspection and test apparatus for
measuring the performance
characteristics of semiconductors, in
Class 9;
installation of capital equipment for
semiconductor manufacturing, namely,
inspection and test systems for
semiconductor manufacturing, in Class
37; and

design, development, and evaluation for the purpose of certification of capital equipment for semiconductor manufacturing for others, namely, inspection and test systems for semiconductor manufacturing, in Class 42.¹

The Examining Attorney has refused registration under Section 2(e)(1) of the Act, 15 USC §1052(e)(1), on the basis that applicant's asserted mark is merely descriptive of a feature, function, use or purpose of applicant's goods and services. Applicant and the Examining Attorney have submitted briefs but no oral hearing was requested.

We affirm.

Relying upon dictionary definitions as well as materials gathered from electronic databases and the Internet, the Examining Attorney argues that the term "optonics" is a shortening of the term "optoelectronic," which is defined by *The Illustrated Dictionary of Electronics* (1997) as "A branch of electronics that involves the use of visible light for communications or data-transfer purposes." The Examining Attorney argues that applicant's goods, inspection and test apparatus for measuring the performance of semiconductors, and

¹ Application Serial No. 75/586,933, filed November 12, 1998, based upon applicant's allegation of a bona fide intention to use the mark in commerce.

applicant's installation, design and development services, may be used in the field of optoelectronics or "optonics." The Examining Attorney maintains that semiconductors² are used in a wide variety of devices and in many different applications including optoelectronics or optonics.

Some of the evidence, including Web pages, upon which the Examining Attorney relies is noted below:

The present invention relates to ensuring an operational readiness state of optical-optoelectronic (or just optonic) instruments for use in tracking, monitoring and guiding systems. Optic-electronic sensor systems are to an increasing extent used for commercial, civilian and military purposes... U.S. Patent No. 4,774,402, issued September 27, 1988).

.....

Second-order nonlinear optical polymeric films, including alternating monomolecular layers of two head-to-head, mainchain, amphophilic, chromophoric polymers, one polymer having the electron donating end of the chromophore attached to hydrophilic groups, and the other polymer having the electron donating end of the chromophore attached to hydrophobic

² A semiconductor is "[a] solid crystalline material whose electrical conductivity is intermediate between that of a metal and an insulator. The optical properties of a semiconductor are important for the understanding and application of the material. Photodiodes, photoconduction detectors or radiation injection lasers, light-emitting diodes, solar-energy conversion cells and so forth are examples of the wide variety of optoelectronic devices." McGraw-Hill Concise Encyclopedia of Science & Technology (2nd edition 1989).

groups, and methods of fabricating the films for use in optonics.

U.S. Patent No. 5,520,968, issued May 28, 1996

.....
...The cost of the SDL facility has been minimized by using an existing 210MeV linac and the 10m long NISUS wiggler, originally build by STI Optonics for Boeing Aerospace.

FOCUS ON.....Accelerator R & D Group

.....
Francois Diederich has been full Professor of Organic Chemistry in the Department of Organic Chemistry at the Swiss Federal Institute of Technology (ETH) in Zurich since 1992. Research in the group headed by Prof. Diederich is structured around the central themes of supramolecular chemistry, medicinal chemistry, novel materials for electronics and optonics based on carbon-rich acetylenic structures, and fullerene chemistry as well as carbon allotropy...

(from biography of Francois Diederich)

.....
...Professor Francois Diederich disclosed his prepartion of functional conjugated materials for optonics and electronics...
Chemistry International, January 1999

.....
...As Arthur C. Clarke reminds us, "As the century that saw the birth of both electronics and optonics draws to a close, it would seem that virtually everything we would wish to do in the field of telecommunications is now technically possible. The only limitations are financial, legal, and political."

Thomas H. Lipscomb, "Great Library" or Great White Elephant?---The Alexandria Library stands at the digital crossroads.

.....
Product Nomenclature

List of different products and optical systems--ophthalmic, precision, optonics--with details of manufacturers 1997-98 GIFO

.....
We are carrying out original campaigns to prolong the prosperity of our industrial park in these days of rapid advances in newly developed industry, such as, mechatronics, optonics and the advanced information industries, into the conventional industrial structure. Daiichi Precision Industry Association

.....
There are many types of "Optonic" Indicators available, however the better ones have a volume control and a tone control...
"Carp-1 FAQ - Tackle," from Catfish Fishing Network, 1998

.....
..asynchronous transfer mode (ATM) switches by first quarter next year to complete construction of its Optonics network alternative to synchronous optical network rivals, it said Thurs. Communications Daily, July 31, 1998

.....
...Sir Leon Brittan wrote to U.S. Trade Representative Charlene Barshefsky yesterday seeking inclusion by the U.S. of photo-optonic chips, optical amplifiers and optical connectors, he said.
AFX News, July 17, 1998

... full-color display. The Boulder-based company's technology won the 1995 Photonics Circle of Excellence Award and the 1994 "Lasers & Optonics" Technology Award. FASTfilter will enable a new generation of full-color display systems to be mounted in lightweight...
The Denver Post, August 7, 1995³

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...During that time Samsung will pocket \$150 billion in profits with which to buy dominance into optonics, multimedia and its big new crusade--autos.
Transpacific, April 1995

.....

...ceramics, Si, InP, GaAs and other compound semiconductors are discussed as well as thin films for applications in electronic, optonic, and optoelectronic devices.
Electronic Materials Technology News, February 1995

.....

...A desktop model called the Mediaplexer that contains an optonic modem, termination for fiber optic signals, tonal controls and a multiplexer to demux and route analog and digital signals is ...
InternetWeek, November 25, 1991

.....

Other listings include biotechnology firms, telecommunications specialists, photonics and optonics firms, medical

³ Applicant has pointed out that there is a magazine entitled "Lasers & Optronics" and that this reference appears to be a misspelling of that name.

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and pharmaceutical companies, and test
and measurement developers.
InfoWorld, April 2, 1990

In addition, the Examining Attorney has made
of record the following page from the Internet.

Applicant, on the other hand, argues that its mark is suggestive. Applicant's attorney has stated throughout the prosecution of this case that the term OPTONICS was coined by applicant's founder to suggest the nature and characteristics of applicant's goods and services. According to applicant's attorney, the term is a "blend" of the words "optics" and "electronics," designed to suggest that applicant's goods relate to both light and electricity.⁴ Applicant argues that the mark OPTONICS does not convey any commonly or readily understood meaning and does not identify any type of product without the use of imagination. Applicant points out that this term is not an established English word, and that it does not appear in

⁴ With applicant's brief, applicant submitted an affidavit of its president stating, among other things, that he chose this term because applicant's products and services were related to the optical electronics field.

I created the term because I was aware from my experience and work in this field that the terms "photonics" and "opto-electronics" were commonly used to describe this field, and I wanted a unique word that was not associated with any web sites and would be associated with my company only.

Though the Examining Attorney did not object to this affidavit submitted with applicant's appeal brief, neither did she discuss it or otherwise treat it as part of the record.

Evidence submitted with an appeal brief is considered untimely. See Trademark Rule 2.142(d) and TBMP § 1207.01. The result we reach herein, however, would not change even if we had considered this affidavit.

eighteen general and technical dictionaries which applicant's counsel has searched. According to applicant, this is evidence that the term is not an established contraction of "optoelectronics."

Concerning the evidence offered by the Examining Attorney, applicant maintains that some of it appears to be from foreign sources and that it shows such varied uses that it is virtually impossible that the term is descriptive of applicant's goods and services. The appearance of this term in these materials, applicant argues, merely shows that others have coined the same term in a variety of contexts. These uses reflect "sporadic" choices by others to combine syllables into a coined word for limited purposes, according to applicant. Applicant argues that the Examining Attorney has not articulated any consistent, coherent definition of the term "optonics," and thus has not proven that applicant's mark would permit a customer unfamiliar with applicant's goods and services to immediately gain an understanding of the function, characteristics or qualities of those goods or services. Applicant maintains that its mark has a meaning only when purchasers can make the association between the term and applicant's goods and services. In sum, applicant maintains that its mark consists of an inventive

combination of descriptive elements which are suggestive of its goods and that applicant's competitors do not use or need to use this term to describe their products or services. Any doubt should be resolved in favor of applicant, applicant urges.

In response to these arguments, the Examining Attorney maintains that the fact that a term is not in the dictionary is not controlling. Also, the fact that many of the products listed in the materials of record are of a widely varied nature merely reflects, according to the Examining Attorney, that electronics are used in conjunction with many products.

A term is merely descriptive under Section 2(e)(1) of the Act if it directly or immediately conveys information about an ingredient, quality, characteristic, feature, nature, function, purpose or use of the relevant goods or services. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987), *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818, 819 (Fed. Cir. 1986), and *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978). On the other hand, a term is suggestive if some imagination, thought or perception is required to determine the nature of the goods or services from the term. The determination of whether a mark is merely descriptive must

be made, not in the abstract, but rather in relation to the goods or services for which registration is sought, the context in which the mark is used or intended to be used, in connection with the goods or services, and the possible significance which the mark may have to the average purchaser of the goods or services in the marketplace. *In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987) and *In re Abcor Development Corp.*, *supra*.

Evidence of what the relevant purchasing public understands a term to mean may come from any competent evidence, including direct consumer testimony, dictionary listings, newspapers, trade journals and other publications. See *In re Bed & Breakfast Registry*, *supra*, and *In re Consolidated Cigar Corp.*, 13 USPQ2d 1481 (TTAB 1989).

Upon careful consideration of this record and the arguments of the attorneys, we conclude that this record is sufficient to establish the mere descriptiveness of the term "OPTONICS."

The record does contain some evidence that the term "optonics" is a shortened form of the word "optoelectronics." The term has been used in a variety of contexts, including in connection with computer chips. Although in this record use of the term may not be entirely uniform, the term is often used to identify a field closely

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associated with electronics. Applicant has acknowledged that the record reflects use by other individuals who may also have coined this term, obviously from the words "optical" and "electronics." We believe that the sophisticated purchasers of applicant's inspection and test equipment for measuring the performance of semiconductors, and its related services, offered and sold under the asserted mark "OPTONICS," are likely to understand the merely descriptive significance of the term in relation to applicant's goods and services. Those purchasers are likely to know that this term describes a feature, characteristic, quality, purpose or use of those goods and services.

Decision: The refusal of registration is affirmed.